

REMARKS / ARGUMENTS

REJECTIONS UNDER 35 USC §101

Examiner has rejected claims 1-15 as being directed to non-statutory subject matter. Specifically, Examiner has stated that claims 1 and 10 do not recite a physical transformation outside of a computer. Accordingly, Applicants have cancelled claims 1, claim 2 (as being dependent on claim 1), claim 10 and claim 11 (as being dependent on claim 10).

REJECTIONS UNDER 35 USC §102

Examiner has rejected claims 1-15 as unpatentable under 35 U.S.C. §102(A) as being anticipated by an ACM conference paper submitted at SIGKDD '03 in August 24-27, 2003, authored by Zhongfei Zhang, John J. Salerno and Philip S. Yu. In a telephone message to Applicants' attorney during the week of October 6, 2008, the Examiner further clarified that the basis for the rejection lies in the presumption that the three (3) authors of the SIGKDD paper (Zhang, Salerno, and Yu), collectively, comprise a different inventive entity than the applicants (Zhang and Salerno).

DISCUSSION

Applicants respectfully make a showing herein that Examiner's rejections under 35 U.S.C. 102(a) are improper based upon the fact that the SIGKDD '03 paper authors Zhang, Salerno and Yu do not comprise a second inventive entity at all. There is only one inventive entity and that is Zhang and Salerno.

As supported by attached affidavits by Zhongfei Zhang and John Salerno, Philip Yu was never an inventor of the subject invention. His contributions to the SIGKDD '03 paper were strictly editorial review, and not substantive. Philip Yu was at no time in possession of knowledge to enable him to practice Zhang and Salerno's invention. As

such Examiner's rejection fails to meet the "...known or used by *others*...before the invention thereof by the applicant..." element of 35 U.S.C. 102(a).

Moreover, and as further supported by Zhang and Salerno's affidavits and attachments thereto, the subject invention was conceived as early as August 2002 as evidenced by the attached DD Form 882 Report of Inventions and Subcontracts prepared by Zhongfei Zhang on August 21, 2002 and as additionally evidenced by the Final Report prepared by Zhongfei Zhang in August 2002 entitled "CORAL: A Data Mining Technique for Automatic Model Generation" which discloses the subject invention in an enabling manner. The report was not published nor otherwise released outside the Air Force Research Laboratory. Applicants argue that because the date of conception of their invention predates the SIGKDD '03 paper, Examiner's rejection further fails to meet the "...known or used by others...*before* the invention thereof by the applicant..." element of 35 U.S.C. 102(a).

Additionally, applicants Zhang and Salerno continued to work on their invention through 2003 as documented in another final report entitled "Uni-Parity Data Community Generation Research and Its Applications", dated August 2003. Likewise, this report was not published nor otherwise released outside the Air Force Research Laboratory. As such, and in the alternative, Examiner's rejection would additionally fail to meet the "...known or used by others...*before* the invention thereof by the applicant..." element of 35 U.S.C. 102(a) in view of applicants' conception (in 2002) prior to any enabling knowledge possessed by Philip Yu (which applicants contend under oath that Yu possessed no enabling knowledge of their invention), and diligent reduction to practice thereafter (through August 2003), at which point their invention was provided to the undersigned patent attorney to prepare for filing patent application 10/800,489 thereon.

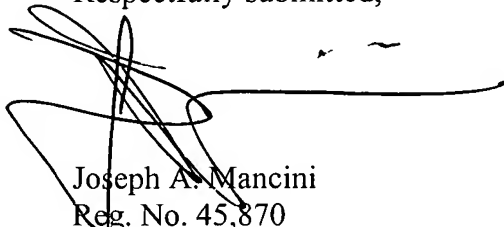
CONCLUSION

Applicants respectfully submit that they have amended their claims in a manner fully compliant with Examiner's requirements and/or submitted arguments that successfully traverse Examiner's grounds for rejection.

Appl. Serial No.: 10/800,489
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Reply to Office Action of September 30, 2008

For all of the reasons advanced above, applicants respectfully submit that the application is in condition for allowance and that action is earnestly solicited. It is therefore respectfully requested that Examiner enter these amendments and present this application for allowance.

Respectfully submitted,



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